REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action.

Objections

Claim 1 is objected to because of a minor informality. Claim 1 has been amended to correct the issue identified by the Examiner. Accordingly, the applicants respectfully request that the Examiner withdraw this objection.

Rejections under 35 U.S.C. § 103

Claims 1-5, 9-11 and 17-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0054589 ("the Nicholas publication"), in view of U.S. Patent Applicatior

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Publication No. 2002/0007393 ("the Hamel publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 4, 19, 26, 32-35, 38 and 40 have been canceled, this ground of rejection is rendered moot with respect to these claims.

Next, independent claims 1 and 36, as amended, are not rendered obvious by the Nicholas and Hamel publications since the cited references neither teach, nor make obvious, ***determining, with a first entity and responsive to an ad request, that a target document is not available for analysis by the first entity to determine if an ad relevant to the content of the target document is available for rendering***.

In rejecting previously presented claim 1, the Examiner states:

> Nicholas teaches *"determining, using a computer system including at least one computer, whether or not a condition is met,"* see Figs. 1,25, and par. 103, "Based on the demographic determination, ad selection node 140 checks for an ad based on the demographic information during a stage S420 of the flowchart 410. During a stage S422 of the flowchart 400, a search of the targeted add within an inventory of ad selection node 140 is accomplished," ***where the claimed "condition" is the referenced check "for an ad based on the demographic information."*** [Emphasis added]

(Paper No. 20090319, pages 2 and 3) The Examiner concedes that:

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> Nicholas does not teach *"and wherein the condition depends, at least in part, on whether the target document is available for analysis by the first entity."*

(Paper No. 20090319, page 3) To overcome this admitted deficiency, the Examiner cites the Hamel publication and states:

> Hamel does, however, see Fig. 3 and par. 83, "During step 315 proxy 158 ***examines the parameters of the ad proposed by the Ad Server 160 to determine if they are compatible with the capabilities of applet*** 132'. If the ad is otherwise compatible with the applet's capabilities, it is passed on through at step 320, where it is then sent by proxy 158 during step 325 to the applet 132'," where, the website and embedded applet must be "available for analysis" in order to determine the "condition" (i.e. ***the referenced determination of whether the ad can be displayed***). [Emphasis added.]

(Paper No. 20090319, page 3) The Examiner then parses the remainder of the recited feature and goes on to state:

> Nicholas teaches "*to determine if an ad relevant to the content of the target document is available for rendering, and if not, determining that the condition is not met,*" see Fig. 25 and par. 103, "***Based on the demographic determination, ad selection node 140 checks for an ad based on the demographic information during a stage S420 of the flowchart 410 ....***"
> [Emphasis added]

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(Paper No. 20090319, page 4) The applicants respectfully disagree.

In exemplary embodiments consistent with the claimed invention, a first entity determines that a target document cannot be analyzed at all for the purpose of determining the content included in the target document which is used to determine if an ad relevant to the content of the target document is available for rendering. Therefore, ***when it is determined that the target document cannot be analyzed in order to determine if an ad relevant to the content of the target document is available for rendering***, the first entity indicates the availability of at least a portion of the resource of the target document to a second entity.

By contrast, if the Nicholas and Hamel publications were to be combined as proposed above by the Examiner, the Nicholas publication would first ***check*** "***for an ad based on demographic information***" of the user (i.e., relevant to the user) and the Hamel publication would then determine whether an ***already selected ad*** "***can be displayed***". More specifically, in the Examiner's proposed combination cited above, the java applet in the Hamel publication is always available for analysis to determine if an ad, which was selected "based on demographic information", is "***compatible with*** the ***capabilities*** of applet [Emphasis added.]". The Hamel publication never describes a situation where the java applet is ***not available*** for analysis to determine if an ad is "compatible with the capabilities of applet". In addition, the Examiner concedes that an ad is selected ***based on demographic information*** and <u>not</u> based on its ***relevance to the content of the target document***.

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Thus, this combination neither teaches, nor makes obvious, that ***the target document is not available for analysis by a first entity to determine if an ad relevant to the content of the target document is available for rendering.***

Furthermore, claims 1 and 36 have been amended to positively recite that the first target document is not available for analysis by the first entity to determine if an ad relevant to the content of the first target document is available for rendering, and therefore the first entity indicates the availability of at least a portion of the resource of the target document to a second entity. These amendments are supported by original claims 1 and 6.

Thus, claims 1 and 36, as amended, are not rendered obvious by the Nicholas and Hamel publications for at least the foregoing reasons. Since claims 2, 3, 5, 9-11, 17, 18, 20-25, 27-31 and 39, as amended, directly or indirectly depend from claim 1, and since claim 37 depends from claim 36, these claims are similarly not rendered obvious by the Nicholas and Hamel publications.

Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication in view the Hamel publication, and in view of U.S. Patent Application Publication No. 2004/0019523 ("the Barry publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Dependent claims 7 and 8 indirectly depend from claim 1. The purported teachings of the Barry

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publication would not compensate for the deficiencies of the Nicholas and Hamel publications with respect to claim 1, discussed above, regardless of the scope of purported teachings of the Barry publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 7 and 8 are not rendered obvious by the cited references for at least this reason.

Claims 12-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nicholas publication in view the Hamel publication, and in view of U.S. Patent Application Publication No. 2003/0220918 ("the Roy publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Dependent claims 12-16 indirectly depend from claim 1. The purported teachings of the Roy publication would not compensate for the deficiencies of the Nicholas and Hamel publications with respect to claim 1, discussed above, regardless of the scope of purported teachings of the Roy publication, and regardless of the absence or presence of an obvious reason to combine these references. Consequently, claims 12-16 are not rendered obvious by the cited references for at least this reason.

Furthermore, claim 12, as amended, is not rendered obvious by the cited references since the cited references do not teach, or make obvious, either (a) indicating, by the computer system of the first entity, the availability of at least a portion of a resource of a target document to the second entity or (b) providing, by the computer system of the first entity, a set of at

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least one ad to be rendered via a resource of a target document depending on whether the first entity determines ***that net revenue for rendering the ad will be positive for the first entity.*** In rejecting claim 12, the Examiner states:

> 12. Nicholas does not teach "The computer-implemented method of claim 4 wherein the condition depends, at least in part, on whether the first entity determines that net revenue for the first entity for rendering the ad will be positive." Roy does, however, see par. 12, "Each advertiser decides how much money he wants to spend on a search term, and the search provider displays the advertisers' listings in proportion to the amount of money the respective advertisers spend," ***where, in order to display an advertisement, the search provider must determine whether the revenue will be positive.*** Thus, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the teachings of the cited references because Roy's teachings would have allowed Nicholas' method to sort advertisements based on revenue, see Roy par. 3. [Emphasis added.]

(Paper No. 20090319, pages 18 and 19) The applicants respectfully disagree.

As can be appreciated from the foregoing, in the Roy publication "each advertiser decides how much money he wants to spend on a search term" and the advertisers' listings are sorted by the search provider "in proportion to the amount of money the respective advertisers spend." However, this does not teach determining whether ***net revenue for rendering the ad will be positive for the***

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first entity. More specifically, the Roy publication does not teach that the determination of whether a condition is met (and therefore of whether a first entity is to provide a set of relevant ads) depends on whether the ***net revenue for rendering the ad will be positive for the first entity***. Furthermore, in embodiments consistent with claim 12, the first entity is an ad serving entity, not an advertiser.

Thus, dependent claim 12, as amended, is not rendered obvious by the cited references for at least this additional reason. Since claims 13-16 directly or indirectly depend from claim 12, these claims are similarly not rendered obvious by the cited references.

New Claims

New independent claim 41 is supported by original claims 1, 7 and 8 and paragraphs [0010], [0011] and [0045].

New independent claim 42 is supported by original claims 1, 12 and 13 and paragraphs [0010], [0011], [0016], [0046] and [0047].

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

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Any arguments made in this amendment pertain ***only*** to the specific aspects of the invention ***claimed***. Any claim amendments or cancellations, and any arguments, are made ***without prejudice to, or disclaimer of***, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted

July 30, 2009

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